

REMARKS

Please reconsider this application in view of the amendments made above and the following detailed remarks. The prior art neither teaches nor suggests the claimed invention, either when the art is individually considered or combined with one another. In the absence of an uncovering of any additional and more relevant prior art, the claimed invention is patentable in that it represents a distinct, non-anticipated and non-obvious invention.

I. Prior Disposition of Claims

The Examiner had objected to Claim 20 because of an informality. More importantly, the Examiner had rejected Claims 1, 8, 10-11, 14-15, 18-21, and 33-34 under 35 USC 102(b) as being anticipated by Newman US 3,217,514. The Examiner further rejected Claims 1, 8, and 11 as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Newman in view of case law. The Examiner also rejected Claims 9, 12-13, 23, 26-27, and 32 under 35 USC 103(a) as being unpatentable over Newman in view of case law. Additionally, the Examiner rejected Claims 5-6 and 16-17 under 35 USC 103(a) as being unpatentable over Newman in view of Mariano, US Patent No. 2,322,461, and further in view of case law. The Examiner rejected Claims 7, 25, and 29-31 under 35 USC 103(a) as being unpatentable over Newman in view of Warren US 6,260,383, and further in view of case law. Furthermore, the Examiner rejected Claim 28 under 35 USC 103(a) as being unpatentable over Newman in view of Chia US 6,532,766, and further in view of case law. Thus, all claims seem rejected because of the teachings of Newman when considered by itself or in combination with other references' teachings and/or the case law.

In response thereto, a discussion follows concerning all objections and rejections including, specifically, the limited teaching of Newman, in comparison to the claimed invention. The Applicant has amended the claims (without the addition of new matter). With the now amended claims defining patentable subject matter, the application is in condition for allowance. The Applicant has canceled Claims 6, 8, 10-11, 13-17, 19-21, and 34. The Applicant has amended Claims 1, 5, 7, 9, 12, 18, 23, 25-28. Currently pending are Claims 1, 5, 7, 9, 12, 18, 23, 25, and 27-33.

II. Objections

The Examiner objected to Claim 20 because the word “remainder” should have read --reminder--. The Applicant has canceled Claim 20.

III. Rejections under 35 USC 102

The Examiner rejected Claims 1, 8, 10-11, 14-15, 18-21, and 33-34 under 35 USC 102 as being anticipated by Newman US 3,217,514. The Applicant has canceled Claims 8, 10-11, 14-15, 19-21, and 34, to advance the prosecution of this application.

For a rejection under 35 USC 102, every aspect of the claimed invention must either be explicitly or impliedly contained in the reference. *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The Examiner asserts that Newman shows an article of jewelry for remembering the hours for an event comprising: a set of primary links 11 each of which is provided with an hour of the day indicating means 12 for indicating one of the sequential hours of the day, a set of connecting links 11, said connecting links 11 being

spaced between said primary links 11 and together with said primary links forming a bracelet, said primary links and/or said connecting links being provided with visual reminder means 25 for reminding the wearer of an event(s) comprising a selectively viewable mechanism 26, 27 associated with each of said primary 11 and/or connecting links 11 to indicate to the wearer which hours of the day correspond to events to be remembered. The Examiner further emphasized that the functional language, such as “for reminding... event(s),” lacking any structural details, held little patentable weight. The Examiner basically ignored the functional language.

The Applicant has amended the claims to replace “hour of the day indicating means for indicating one of the sequential hours of the day” which the Examiner ignored because of his position that it was functional with “sequential, hour of the day indicators, a distinct indicator for each link, for visually indicating the hour of the day associated with said primary link” and replaced “visual reminder means for reminding the wearer of an event(s), comprising” with “at least one rotatable knob having two or more visually distinct marker faces, said marker faces being turnable by said knob while said bracelet is worn by a wearer so that a selected and distinct face is viewable to the wearer... in association with said link.” The Applicant has removed alleged functional language and replaced such language with structure, the details structurally distinguish Applicant’s claims from the teaching of Newman ‘514.

Newman ‘514 teaches an article of jewelry comprising an ornamental bracelet. A set of identical links are connected together which the Examiner states could be considered as alternating (yet identical) primary and connecting links. There is no visual indicator provided to distinguish one primary link from another. Yet this claimed structural detail is essential to operation of the invention

of the present application. Mainly, Newman's structure includes a set of body members or links with a central opening, and a rotatable ornamental member with two faces, pivotable trunnions, and spring means. Newman's structure focuses on a pivotal ornamental member for a jewelry device. The ornamental member may be converted from one ornamental face to a second, flip-side, ornamental face. This, however, cannot be done while the wearer is wearing the bracelet since the "points" of the face would dig into the wearer. The present invention, by using a rotatable knob, as claimed, allows for easy changing of the marker faces.

Applicant's invention teaches an article of jewelry for remembering the hour(s) for an event(s) in the course of the day with the claimed sequential hour of the day indicators providing a distinct indicator for each link, all links providing a set of hours of the day, yet each link being visually distinct from adjacent links so that the wearer can determine what hour of the day is associated with that link. This is not present with Newman which shows identical links. The claimed invention also comprises a rotatable knob with two or more visually distinct marker faces to visually present a distinct face in association with said link. Applicant's claimed invention allows for knob rotation even while the bracelet is worn whereas Newman does not. Newman '514 lacks the structural features of the present invention which are necessary to properly carry out the purpose of the present invention - to allow the wearer of the article of jewelry to rotate a knob to facilitate remembering the hour for an event. Foremost, Newman's structure lacks any hour of the day indicators! Each link is identical to each adjacent link. Without such claimed hour of the day indicators, a viewer cannot determine the particular hour of the day to remember the event. Yet, this is the whole purpose of the claimed invention.

To facilitate the Examiner's review and his understanding of the invention, attached hereto

are color photographs showing several actual embodiments of the claimed invention. It is clear that primary links are connected to form a bracelet. The primary links are provided with a set of sequential hour of the day indicators, a distinct one for each link to show the hour of the day that an event may need to be remembered during the day and the link associated with that hour. Furthermore, one can see the rotatable knob with two or more (preferably four) faces which selectively present a distinct marker face viewable to the wearer in association with the links. The claimed invention is not anticipated nor rendered obvious by the prior art. The knob can be easily rotated while the bracelet is worn. The claimed invention, its structure, is patentable. Newman does not teach the association of hour of the day indicators with each link so that a unique hour is associated with one link. Newman does not teach a rotatable knob which can be rotated while the device is being worn (unless the device is loosely made and discomfort tolerated).

For the top embodiment of the submitted examples of the invention, the primary links are provided with Roman numerals, each link having a distinct numeral thereon. Thus, a set of sequential hour of the day indicators are provided to the links, a distinct indicator for each primary link. The rotatable knobs show at least two distinct visual markers, one such knob for each link. Thus, a distinct marker can be presented by rotating its knob, while the bracelet is worn, to present a distinct marker face for each primary link. The wearer then knows the hour of the day for an event. This is not shown nor suggested by Newman. The claimed invention is not taught by the prior art.

The middle bracelet of the photographic submission shows primary links with Roman numerals, along with rotatable knobs in association with the primary links. The third embodiment of the submission again shows a set of primary links with Roman numerals as the set of sequential visual indicators, a distinct indicator for each primary link. In this embodiment, the interspersed

connector links show analog hour of the day clock faces and individual stones to show the hour of the day corresponding to the connecting link and the adjacent/attached primary link. In this case, it should be apparent that the connecting links are the links to the right of the primary links. One thus sees, primary links for 7 o'clock; 8 o'clock; 9 o'clock and 10 o'clock; and connecting links, starting from the extreme left for 6, 7, 8, and 9 o'clock.

Furthermore, Newman does not teach nor claim a rotatable knob with two or more visually distinct faces which can be rotated while the bracelet is worn. The Examiner asserted that ornamental member 25 is a knob with two different faces. Applicant disagrees. Applicant's invention includes a face of the link, which does not move and is separate and distinct from its claimed rotatable knob. When the knob is rotated, the face of the jewelry article remains in the same position. Structurally, the ornamental member of Newman further differs from Applicant's rotatable knob in a number of ways. Newman's ornamental member allows for pivoting through the use of trunnions. The ornamental member swings either of the obverse faces into parallelism with the obverse face of the body member. Essentially, the Newman ornamental member is structurally defined much like a flipping plate. On the other hand, Applicant claims a rotatable knob. A rotatable knob is moveable, without removing the bracelet, by turning the same between the thumb and forefinger. The knob is rotatable with respect to the primary and/or connecting link, and in conjunction with the hour of the day indicators for that link, allows the wearer to remember the hour for an event.

Newman '514 lacks the structural features of the present invention which are necessary to properly carry out the purpose of the present invention. Newman '514 does not teach hour of the day indicators nor a rotatable knob. Newman does not teach the structural limitations of the

present invention because it lacks sequential hour of the day indicators and a rotatable knob having two or more visually distinct marker faces. Since the prior art does not teach all of the structural limitations of the present invention, Claim 1 is not anticipated.

The Examiner rejected Claim 18 under 35 USC 102(b) as also being anticipated by Newman 3,217,514. The Examiner argued that Newman further discloses a biasing mechanism 28, 30 comprising an axle 28 of square cross-section and a resilient spring 30 bearing against a flat surface of said axle for ensuring that said visual reminder means 25 is maintained in place until manually moved into a new orientation. The Applicant has amended independent Claim 1 to include limitations not found in the prior art and is now in condition for allowance. Since Claim 18 depends from independent Claim 1, Claim 18 is no longer believed anticipated by Newman for the same reasons.

The Examiner rejected Claim 33 because Newman discloses an article of costume jewelry as claimed in Claim 1 and Claim 11. The Applicant has amended independent Claim 1 to include limitations not found in the prior art and is now in condition for allowance. Since Claim 33 depends from independent Claim 1, Claim 33 is no longer anticipated by Newman for the same reasons.

Applicant respectfully asks the Examiner to withdraw the rejections of the Claims as being anticipated by Newman 3,217,514 under 35 USC 102(b) because Newman no longer teaches every aspect of the claimed invention.

V. Rejections under 35 USC 103

The Examiner has rejected Claims 1, 8, 9, 11-13, 23, 26-27, and 32 under 35 USC 103(a)

as being obvious over Newman '514 in view of case law. In essence, the Examiner asserts that a one-piece construction, in place of separate elements fastened together, is a design consideration within the skill of the art. In re Kohno, 391 F.2d 959, 157 USPQ 275 (CCPA 1968); In re Larson, 340 F.2d 965, 144 USPQ 347 (CCPA 1965). Thus, the Examiner feels that multiple links, viewing mechanisms, and the like are obvious design considerations in regard to prior art with similar singular structures. The Applicant has amended Claims 1, 5, 7, 9, 12, 18, 23, 25-28 and the Applicant has canceled Claims 8, 11, and 13.

The Examiner rejected Claim 1 under 35 USC 102(b) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Newman '514 in view of case law. The Examiner asserts the same arguments as aforementioned, but further argued that case law provides the basis for the interpretation that one-piece construction, in place of separate elements fastened together, is a design consideration within the skill of the art. Applicant does not disagree with the basic premise but respectfully traverses the conclusion with respect to the claimed invention and further emphasizes the claimed structural differences between the Applicant's invention and that of Newman '514 mentioned earlier. Since the Applicant's invention includes limitations that are undisclosed and not suggested by Newman, the obviousness rejection, in view of case law, becomes moot. Applicant respectfully requests that the rejection be withdrawn.

The Examiner rejected Claims 9 and 12 under 35 USC 103(a) as being unpatentable over Newman in view of case law. Again, the Applicant's amended independent claim 1 includes structural limitations not found in Newman '514. Since Claims 9 and 12 depend from Claim 1, Claims 9 and 12 are also believed now allowable.

The Examiner rejected Claim 23 under 35 USC 103(a) as being unpatentable over Newman in view of case law. As to Claim 23, the Examiner asserts that Newman discloses that each of said primary links 11, 11, 11, 11, comprises an analog watch face design and a marker gem 26 is provided for each hour for which an event may occur in a day and each primary link 11, 11, 11, 11, 11 further comprising: at least one rotatable rosette 25, 25, 25, 25 having two or more different stones 26, 26, 26, 26 such that only one stone, at any one time is viewable. Applicant has amended Claim 23 and replaced “marker gem is provided for each hour...” with “sequential, hour of the day indicators...” Based on the same rationale set forth above, this limitation is not taught by Newman. Applicant respectfully requests that the Examiner withdraw the rejection.

The Examiner rejected Claims 26, 27, and 32 under 35 USC 103(a) as being unpatentable over Newman in view of case law. Again, the Applicant’s amended independent claim 23 includes structural limitations not found in Newman ‘514. Since Claims 26, 27, and 32 depend from Claim 23, Claims 26, 27, and 32 are also now allowable.

The Examiner rejected Claims 5-6 and 16-17 under 35 USC 103(a) as being unpatentable over Newman ‘514 in view of Mariano ‘461, and further in view of case. The Examiner asserts that it would have been obvious to one of ordinary skill in the art, having the disclosures of Newman and Mariano before him at the time the invention was made, to modify the aesthetic design of the indicating means 12 of Newman to look like Arabic numerals, as taught by Mariano, to obtain an hour of the day indicating means consisting of Arabic numerals. The Examiner further argues that one would have been motivated to make such a combination because a change in ornamental design having no mechanical function is an aesthetic design

consideration within the skill of the art.

The Applicant has canceled Claims 6 and 16-17. The Applicant has amended Claim 5 by removing “hour of the day indicating means...” and replacing the phrase with “indicators.”

Claim 5 depends from independent Claim 1 which was amended to include further limitations not taught by Newman or Mariano. These limitations include sequential hour of the day indicators, one for each primary link, and a rotatable knob having two or more visually distinct marker faces. Based on the arguments made above, Claim 5 as amended is allowable. Applicant respectfully requests that the Examiner withdraw the rejection.

The Examiner rejected Claims 7, 25, and 29-31 under 35 USC 103(a) as being unpatentable over Newman ‘514 in view of Warren ‘383, and further in view of case law. As to claim 7, the Examiner asserts Newman discloses, wherein said set of primary links 11 are provided with aesthetic designs 12, and said set of connecting links 11 are provided with an analog watch face and a hour of the day marking stone 26. The Examiner argues Warren teaches the use of Roman numerals as an aesthetic design and that one would have been motivated to make such a combination because a change in ornamental design having no mechanical function is an aesthetic design consideration within the skill of the art. Claim 7 depends from independent Claim 1 which was amended to include further limitations not taught by Newman or Warren. These limitations include sequential hour of the day indicators and a rotatable knob having two or more visually distinct marker faces. This is structural, provides function to the device, and is not merely nor even primarily aesthetic. Claim 7 also has a further limitation - that the connecting links be provided with an analog watch face. Neither Newman nor Warren includes this limitation. As to Claims 25, and 29-31, the Applicant further emphasizes the structural

limitations of the independent claims they depend from. Applicant respectfully requests that the Examiner withdraw the rejections.

The Examiner rejected Claim 28 under 25 USC 103(a) as being unpatentable over Newman in view of Chia 6,532,766 and further in view of case law. The Examiner asserts that Newman discloses, an analog watch face design and marker gems 26, comprised of gems and Chia discloses the equivalence of using an actual diamond or other gem. Claim 28, as amended, depends from independent Claim 23 which now includes limitations not taught by the prior art, mainly sequential, hour of the day indicators. Thus, since Claim 23 is allowable, and Claim 28 depends from Claim 23, Claim 28 is also now allowable.

VI. Conclusion

Applicant believes that this paper is responsive to each and every ground of objection and rejection cited by the Examiner in the Action dated November 19, 2003, and respectfully requests favorable action in this application. **The Examiner is invited to telephone the undersigned to discuss any further changes that might be deemed necessary.** Prompt and favorable action toward the issuance of a patent is earnestly solicited and believed to be fully warranted.

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Respectfully submitted,



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